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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,535	03/26/2001	Hector Franco	HFRANCO.001A	6849

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 09/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/817,535

Applicant(s)

FRANCO, HECTOR

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 9-14, 16-18 and 20-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6, 9-14, 16-18 and 20-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection.

Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 04 June 2005 has been entered.

Response to Amendment

The Applicant canceled claims 7, 8, and 19, amended claims 1, 9, and 16, and newly added claims 20-22. All pending claims (1-4, 6, 9-14, 16-18, and 20-22) were examined in this non-final office action.

Response to Arguments

Applicant's arguments, see Remarks, filed 04 June 2005, with respect to the rejection(s) of claim(s) 1-4, 6, 9-14, 16-18, and 20-22 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Combini, Netship, and Yamada. Combini teaches an online shopper shopping a plurality of online merchants and designating a convenience

store as a delivery destination for customer pickup for orders. Netship teaches a store location as an aggregation site for a plurality of online merchants for customers to pickup online orders. Yamada fills in the gaps on delivery logistics and communication between online merchants, the delivery system, the designated convenience store, and the online shopper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1, 2, 6, and 20 are rejected under 35 USC 103(a) as being unpatentable over Combini (Paper #20041104, Item: X) in view of in view of Netship (Paper #20041104, PTO-892, Item: U).**

Combini teaches Internet retailing that provides payment and pick-up convenience for online shoppers for a plurality of purchased items at alternate delivery locations that are convenient for the online shopper. Combini further teaches:

- each of the items is ordered by the consumer from a different one of a plurality of merchants: online shoppers choosing one of the 8,000 7-Eleven locations where they would like to have merchandise (e.g.

videos, books) ordered online delivered for pick-up (please note:

i) 7-Eleven Japan in partnership with multiple Internet merchants who sell books and videos over the Internet, ii) a plurality of items purchased by an online shopper are associated with the online shopper for pick-up at a designated location, iii) shopper who picks up ordered items at a location is having these ordered items transferred to the customer by the store facilitating the transaction) (Paper #20041104, Item: X: see at least page 2); Internet merchants putting the Lawson icon on their home pages, which shoppers can click to arrange to pick-up and pay for goods at a Lawson store (Paper #20041104, Item: X: see at least page 2)(please note: store is transferring goods to the shopper).

- for each consumer, receiving the associated items at a single geographic location: online shoppers choosing one of the 8,000 7-Eleven locations where they would like to have merchandise delivered (Paper #20041104, Item: X: see at least page 2); Internet merchants putting the Lawson icon on their home pages, which shoppers can click to arrange to pick-up and pay for goods at a Lawson store (Paper #20041104, Item: X: see at least page 2)(please note: store is transferring goods associated with the shopper).
- merchant receives instructions: Inherent in Combini are the structures necessary to permit the merchant receiving instructions. For example,

online shopper clicks Lawson icon located on online merchant home page resulting in shopper's purchased merchandise being delivered to a Lawson store (Paper #20041104, Item: X: see at least page 2).

Merchant received delivery instructions pertaining to the Lawson store selected by the shopper to complete fulfillment to the Lawson store for shopper pick-up.

Comбини teaches all the above as noted under the 103(a) rejection and teaches a) use of computer technology for online ordering and delivery location determination, b) using a network of convenience stores as alternate goods delivery locations for online shoppers and associating an order of items with a single customer, and c) a single customer ordering goods from a plurality of merchants and picking up ordered goods at a convenience store, but does not specifically disclose physically aggregating these items at a location. NetShip teaches Netship providing online merchants access to a network of Parcel Plus store locations as alternate goods delivery locations for online shoppers. NetShip teaches Parcel Plus store locations serving as virtual warehouses and pick-and-pack operations (please note: what to pick and pack requires instructions from merchants) for online merchants to preposition inventory closer to their ultimate customers (please note: an aggregation point for merchants). NetShip further teaches online merchants being able to provide one day ground service to a customer from a Parcel Plus store location or letting the "customer pick up the items at the Parcel

Plus location" (please note: items associated with the customer are being transferred to the customer, and were aggregated since the customer is picking more than one item) (Paper #20041104, Item U: see at least page2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Combini to allow a customer to pick up ordered items from merchants at an aggregation site as taught by NetShip, in order to provide a delivery convenience for online shoppers, and thereby attract customers to the online service.

Combini teaches all the above as noted under the 103(a) rejection but does not disclose delivering from the aggregation site. NetShip teaches all the above as noted under the 103(a) rejection and further teaches online merchants being able to provide one day ground service to a customer from the location (e.g. a Parcel Plus store) (Paper #20041104, Item U: see at least page2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Combini to provide goods delivery from the aggregation site to the customer as taught by Netship, in order to provide a customer convenience, and thereby attract customers to the online service.

- 2. Claims 3, 9-14, 16-18, and 21 are rejected under 35 USC 103(a) as being unpatentable over Combini (Paper #20041104, Item: X) and Netship (Paper**

#20041104, PTO-892, Item: U), as applied to claim 1, further in view of Yamada (Paper #20041104, US 6,336,100).

Combini and NetShip teach all the above as noted under the 103(a) rejection and teach a) using convenience stores (known as combinis) serving as convenient delivery locations for online shoppers, and b) online shoppers picking up their aggregated orders at a store location, but do not disclose specifics about the transaction and communication among transaction participants. Yamada teaches an online shopping system and method connecting a plurality of online consumer terminals to a plurality of virtual stores via the Internet as a communication system (see at least abstract; Fig. 1 (1, 2, 3, 9); col. 1, lines 4-15; col. 2, lines 10-24). Yamada teaches a consumer designating a convenience store as a delivery location convenient to the consumer for package pick-up. Yamada further teaches:

- Presenting to the consumer a set of at least one predetermined geographic location from which the consumer is prompted to make a selection: consumer makes a station selection from a predetermined list of geographic locations (see at least Figs (4-6); col. 4, lines 31—41).
- Merchant receives instructions: merchant is aware of consumer-selected location (see at least Fig. 1 (1, 4-9); col. 2, line 10 through col. 3, line 37).
- Pending notification; receiving a notification of receiving a delivery: system provides notification of delivery to the consumers specified delivery location (please note: provided indication that consumer is to pickup

his/her order)(see at least col. 3, lines 55-57). Inherent in Yamada are the structures necessary to permit pending notification. For example, the user checks the system for delivery confirmation. Absent of a confirmation of the delivery to the designated location, the user knows the delivery is pending.

- Providing identification: consumer provides ID information (see at least col. 3, line 66 through col. 4, line3).
- Identifying/providing a consumer date and time: consumer expects delivery directly to home or to alternate delivery location at time and date specified; time and date the customer expects delivery (see col. 3, lines 15-18).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Combini and Netship to implement business transactions as taught by Yamada, in order to facilitate transactions between online merchants, online shoppers, and order aggregation locations and thereby attract shoppers to the online service.

3. **Claim 4 is rejected under 35 USC 103(a) as being unpatentable over Combini (Paper #20041104, Item: X) and Netship (Paper #20041104, PTO-892, Item: U), as applied to claim 1, further in view of Yamada (Paper #20041104, US 6,336,100), further in view of Official Notice (regarding old and well known in the arts, hereinafter referred to as "ON1").**

Combini and NetShip teach all the above as noted under the 103(a) rejection and teach a) using convenience stores (known as combinis) and pack-and-ship locations serving as convenient delivery destinations for online shoppers, and b) customers picking up their aggregated orders at a store location, but do not disclose specifics about the transaction and communication among participants. Yamada teaches an online shopping system and method connecting a plurality of online consumer terminals to a plurality of virtual stores via the Internet as a communication system (see at least abstract; Fig. 1 (1, 2, 3, 9); col. 1, lines 4-15; col. 2, lines 10-24). Yamada teaches a consumer designating a convenience store as a delivery location convenient to the consumer for package pick-up.

Yamada further teaches:

Pending notification; receiving a notification of receiving a delivery: system provides notification of delivery to the consumers specified delivery location (please note: provided indication that consumer is to pickup his/her order)(see at least col. 3, lines 55-57). Inherent in Yamada are the structures necessary to permit pending notification. For example, the user checks the system for delivery confirmation. Absent of a confirmation of the delivery to the designated location, the user knows the delivery is pending.

Combini, Netship, and Yamada teach all the above as noted under the 103(a) rejection and teach a) providing pending delivery notification to a shopper, and b) completed delivery notification to a shopper, but do not disclose a partial delivery notification to a shopper. The Examiner takes the position that it is old and well

known in the arts for merchants to indicate to an inquiring shopper as a customer convenience that a partial delivery has been received. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Combini, Netship, and Yamada to implement partial delivery notification as taught ON1, in order to provide a customer convenience, and thereby attract shoppers to the online service.

- 4. Claim 22 is rejected under 35 USC 103(a) as being unpatentable over Combini (Paper #20041104, Item: X), Netship (Paper #20041104, PTO-892, Item: U), as applied to claim 21, further in view of Yamada (Paper #20041104, US 6,336,100), further in view of Official Notice (regarding old and well known in the arts, hereinafter referred to as "ON2").**

Combini and NetShip teach all the above as noted under the 103(a) rejection and teach a) using convenience stores (known as combinis) and pack-and-ship locations serving as convenient delivery destinations for online shoppers, and b) customers picking up their aggregated orders at a store location, but do not disclose specifics about the transaction and communication among participants. Yamada teaches an online shopping system and method connecting a plurality of online consumer terminals to a plurality of virtual stores via the Internet as a communication system (see at least abstract; Fig. 1 (1, 2, 3, 9); col. 1, lines 4-15; col. 2, lines 10-24). Yamada teaches a consumer designating a convenience

store as a delivery location convenient to the consumer for package pick-up.

Yamada further teaches:

Identifying/providing a consumer date and time: consumer expects delivery directly to home or to alternate delivery location at time and date specified; time and date the customer expects delivery (see col. 3, lines 15-18).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Combini and Netship to implement consumer expected date and time of delivery as taught by Yamada, in order to provide a customer convenience, and thereby attract shoppers to the online service.

Combini, Netship, and Yamada teach all the above as noted under the 103(a) rejection and teach a) identifying a time and date for delivery expected by the consumer, and b) transmitting to the consumer a completed delivery notification, but do not disclose estimating a delivery time for an item. The Examiner takes the position that it is old and well known in the arts for merchants or carriers to indicate to an inquiring shopper as a customer convenience delivery time estimates for purchased goods being shipped to a delivery destination. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Combini, Netship, and Yamada to implement partial delivery notification as taught ON2, in order to provide a customer convenience, and thereby attract shoppers to the online service.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Schnabel, Megan; "Changing Chains Brendle's Closing More Bad News for Catalog Showroom Industry," Roanoke Times & World News, 21 July 1996, Proquest #15758804, 5pgs; teaches Best Products credited by many with pioneering the catalog showroom concept: shoppers browsing through aisles of merchandise displays, jotting down the item numbers of products they wanted to buy; the order slips would be sent to a back room, where stockers would pick out the merchandise and deliver it to a counter for customer pick-up; by filling their store shelves with just one sample of each product, Best could offer a wider selection of goods than traditional variety stores.
- Joselow, Froma; "Self-serving Convenience, more stores are letting the shopper go it alone," Providence Journal, 16 April 1989, Proquest #59599571, 3pgs; teaches Service Merchandise catalog showroom model: shoppers strolling through a display of vacuum cleaners and comparing models, using a sales slip to record orders, handing it to a cashier who punches in a code and take payment, and taking receipt of the purchased item at a delivery area near the store's exit.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M. Pond whose telephone number is 703-605-4253. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robert M. Pond
Primary Examiner
September 6, 2005